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PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Application No. :10/532,666 Confirmation No.: 8703
Applicant :Baret et al
Filed :April 17, 2006
Title :METHOD FOR PARAMETERING
A FIELD DEVICE OF AUTOMATION
TECHNOLOGY
TC/A.U. :2184
Examiner : E. Mamo
Docket No. : BARE3001 /FJD
Customer No. :23364

BRIEF ON APPEAL TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Brief on Appeal in the above-identified application.

1. An Oral Hearing is requested.
2. An Oral Hearing is requested on _____.
3. An extension of time for filing the Brief on Appeal
 is hereby requested.
 was requested on _____.

4. The fee is calculated as follows:

Filing Brief on Appeal	\$ 540.00	(large)	\$
(small)			
Request for Oral Hearing	\$	\$	\$
Request for an _____ Extension of Time	\$	\$	\$

5. No fee required.
6. A check in the amount of \$ 540.00 is enclosed.
7. Please charge Deposit Acct. No. 02-0200 in the amount of \$ _____.
8. The Commissioner is hereby authorized to charge underpayment of any fees during the pendency of this application or credit any overpayment to Deposit Account No. 02-0200 _____.

Respectfully submitted,

Felix J. D'Ambrosio
Reg. No. 25,721

Date: January 28, 2009

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BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22202-3514

Sir:

INTRODUCTORY COMMENTS

Pursuant to the provisions of 37 CFR 41.37, submitted herewith is Applicant/Appellant's Brief on Appeal along with the required fee.

Any additional fees necessary for this appeal may be charged to the undersigned's Deposit Account No. 02-0200.

REAL PARTY IN INTEREST

(37 CFR 41.37(c)(1)(i)

The real party in interest is Applicant/Appellant's assignee, Endress + Hauser GmbH + Co. KG. The assignment was recorded on April 18, 2006 at Reel 017499 and Frame 0642.

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RELATED APPEALS AND INTERFERENCES

(37 CFR 41.37(c)(1)(ii))

There are no related appeals or interferences with respect to the invention defined in this application.

STATUS OF CLAIMS

(37 CFR 41.37(c)(1)(iii))

Claims 1 - 3 have been cancelled.

Claims 4 - 6 are pending in this application.

Claims 4 - 6 have been finally rejected.

STATUS OF AMENDMENTS

(37 CFR 41.37(c)(1)(iv))

A REQUEST FOR RECONSIDERATION WITH AMENDMENT was filed in response to the Office Action of July 28, 2008. The amendment was to claim 4 by which “on-signed” was to be changed to “on-site.” An obvious error, which the examiner refused to enter alleging that the amendment “raise new issues that would require further consideration and/or search.” In his explanation on page 3 of the Advisory Action of December 11, 2008, the examiner stated that because of the “proposed amendment, a new search technique need to be formulated and further search need to be conducted.” Why? The amendment was proposed to correct an obvious error. Note claim 1 of the claims included in the English translation filed with the RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS filed on April 17, 2006 as well as the PRELIMINARY AMENDMENT filed with the noted RESPONSE, both of which state “on - site.” Line 5 of claim 4, which was not changed also recites “on-site operating means.”

The error was introduced by the RESPONSE filed April 28, 2008. It was this error that applicant was attempting to correct.

Accordingly, an amendment is being filed concurrently herewith to correct

claim 4. The claim listing in the attached APPENDIX OF CLAIMS includes the corrected claim 4.

SUMMARY OF CLAIMED SUBJECT MATTER

(37 CFR 41.37 (c)(1)(v))

(References are to page and line of the specification)

The invention described and claimed is directed to a method for parametering a field device (pg. 1, lines 2 and 3). Before startup and at any time for varying the functions of the field device, the field devices must be parametered. For the parametering, an on-site operating means is, as a rule, available, such being integrated into the relevant field device (pg. 1, lines 18 -21). An essential idea of the present invention is that an on-site operation of a second field device is used for the parametering of a first field device (pg. 2, lines 18 - 20). Fig. 1 shows field devices F1 and F2. These are connected by a fieldbus FB (pg. 3, lines 9 and 10). Each field device has a microprocessor and on-site operating means including operating display software (pg. 3, lines 22 - 27). The operating software contains a complete description of the operating structure and the presentation layout for the relevant field device (pg. 4, lines 2 - 4). The fieldbus communication software contains a remote parametering layer, and via this layer, either a request for remote parametering is initiated or an external request for remote parametering is reacted to. In *independent claim 4*, the present invention is defined with six (6) steps relative to a first field device. The steps include: providing a second field device; providing an on-site operating means which is connected to the second field device; activating a remote parametering mode; selecting the first field device to be parametered; accessing the operating software of the first field device *from the second field device*; and then exchanging parametering data via the fieldbus wih he first field device to be parametered.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(37 CFR 41.37(c)(1)(vi))

A single issue is raised by this appeal, namely, are claims 4 - 6 unpatentable under 35 USC 103(a) over Packwood et al in view of McAlear.

ARGUMENT

(37 CFR 41.37(c)(1)(vii))

Packwood et al teaches a plurality of field devices connected to a fieldbus. As such, the field devices are connected to each other. But that fact alone cannot justify stating that they communicate with each other. The examiner apparently recognizes this fact and states in his final rejection “[h]owever, Packwood et al '356 does not teach the steps of activating a remote parametering mode at said on-signed [sic] operating means.” The examiner then turns to McAlear. McAlear refers to a remote control of computer network activity and is particularly concerned with providing remote users with means for manipulating of data objects and initiation of applications between collaborating computers. In particular, McAlear refers to a wireless remote for controlling computers remotely over a data network. The wireless remote control system includes remote access programs running on data network servers, which provide access to, and disposition of data objects. The wireless remote control system disclosed by McAlear is particularly useful for overcoming the difficulty of handling data over a low bandwidth wireless link with the minimal display facilities of a wireless handset or Personal Digital Assistant, and of providing linkage between data objects on one computer and application residing on another computer under the direct supervision of the user without the data objects needing to traverse the low bandwidth link.

But this is not the present invention being claimed. It is clear that McAlear does not disclose field devices or their connection to each other via a fieldbus. McAlear also does not disclose that one field device has an on-site operating means, which is certainly not a PDA or a keyboard or a mouse. That means that not every field device

has an on-site operating means. Also, McAlear fails to disclose that a second field device in the fieldbus architecture is parametered via the on-site operating means of the first field device. These distinctions are important to the invention and neither Packwood or McAlear disclose them.

It is difficult to see how or why Packwood et al and McAlear are combinable. One deals with a process control system including multi-protocol field devices (Packwood et al), whereas the other deals with the remote control of a computer network (McAlear). The problems that each addresses are different and the solutions are tailored to the problem addressed. Neither patent shows or suggests the claimed steps of claim 4 as a solution to the problem faced by applicants. See, *In re Wright*, 6 USPQ2d 1959 (Fed. Cir. 1988), which would conclude that a *prima facie* case of obviousness is not made by the combination of Packwood et al and McAlear. Why would the person skilled in the art consider the teaching of McAlear when he starts with Packwood et al, given the differences in the two disclosures? This would not be expected from a common sense point of view. See, *KSR International Co. v. Teleflex Inc.* 82 USPQ2d 1385 (Sup. Ct., 2007) where the Supreme Court instructed us to look to “common sense” when applying 35 USC 103. Would McAlear offer a “predictable variation” for the person skilled in the art, given the person skilled in the art’s knowledge of Packwood et al? It is respectfully submitted that **KSR** would say no because the teaching of McAlear does not present a “variation” (predictable or otherwise) of the teaching found in Packwood et al.

CONCLUSION

In view of the above, it is respectfully submitted that the final rejection of claims 4 - 6 based upon the combination of Packwood et al and McAlear should be reversed and the examiner directed to allow claims 4 - 6.

Respectfully submitted

BACON & THOMAS, PLLC

Date: January 28, 2009


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APPENDIX OF CLAIMS
(37 CFR 41.37 (c)(1)(viii))

Claims 1 - 3 (Cancelled).

4. A method for parametering a first field device in process automation technology connected with a fieldbus, comprising the steps of:
 - providing a second field device connected with the fieldbus;
 - providing an on-site operating means connected to the second field device;
 - activating a remote parametering mode at an on-site operating means;
 - selecting the first field device to be thereby parametered;
 - accessing of an operating and display software of the first field device from the second field device; and
 - exchanging parametering data via the fieldbus with the first field device to be parametered.
5. The method as claimed in claim 4, further comprising the step of:
exchanging the parametering data in a proprietary protocol, which is built on top of a fieldbus protocol (HART®, PROFIBUS®, FOUNDATION FIELDBUS®).
6. The method as claimed in claim 4, further comprising the step of:
exchanging the parametering data in a fieldbus protocol (HART®, PROFIBUS®, FOUNDATION FIELDBUS®).

EVIDENCE APPENDIX

There is no evidence being relied upon which was submitted pursuant to
37 CFR 1.130, 1.131 or 1.132.

RELATED PROCEEDINGS APPENDIX

There is no related proceeding being relied upon.

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